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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/630,080	07/30/2003	Adam G. Hanes	1449/5	8470
25297	7590	10/28/2005	EXAMINER	
JENKINS, WILSON & TAYLOR, P. A. 3100 TOWER BLVD SUITE 1400 DURHAM, NC 27707			PETERSON, KENNETH E	
			ART UNIT	PAPER NUMBER
			3724	

DATE MAILED: 10/28/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

## Office Action Summary

Application No.

10/630,080

Applicant(s)

HANES ET AL.

Examiner

Kenneth E. Peterson

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 09 September 2005.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-5,8,9,12-14,16,23 and 30 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-5,8,9,12-14,16,23,30 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |  |   |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)   | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                                   | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____  |

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1. Claims 13 and 16 are objected to because the transverse shield wall is redundantly recited relative to parent claim 12.

Appropriate correction is required.

2. Claims 1-5,8 and 9 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Applicant has stated that Claim 1 is drawn to the shield by itself, and not drawn to a combination of the shield and the cutting mechanism. However, Applicant has amended claim 1 so that the body of the claim is so intertwined with the cutting mechanism that it is difficult to interpret the shield solo.

On one hand, Applicant has stated that the claim should be considered as just the shield.

On the other hand, MPEP 2173 has In re Larsen, which requires the Examiner give weight to elements positively recited in the body of the claims (like the cutting mechanism) even if they are outside of the scope of the preamble.

This conflict makes the scope of the claim unclear. For at least this action, Examiner will try to interpret the claims as just the shield.

3. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

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(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

4. Claims 12-14,16,23 and 30 rejected under 35 U.S.C. 102(b) as being anticipated by Byrne '126, who shows a head assembly in having a 1<sup>st</sup> lateral wall (e.g. 45), a 1<sup>st</sup> transverse shield wall (e.g. at 41 in figure 5A) and a 2<sup>nd</sup> lateral wall (vertical wall between 21 and 43a in figure 5a) that is gapped from the distal head section.

Byrne also shows an adaptor member (23a) in an aperture, an output shaft (2) and a cutter (6) having an annular rim (5).

5. Claims 1,2,5 and 8, as best understood, are rejected under 35 U.S.C. 102(b) as being anticipated by Lill '165, who shows a head assembly having a 1<sup>st</sup> lateral wall (e.g. 43), a 1<sup>st</sup> transverse shield wall (39), a 2<sup>nd</sup> lateral wall (vertical sidewalls of 12) having an annular gap filled by a hollow sleeve member or adaptor member (21 or 22,22), a coaxial adaptor wall (23 or 24), a shaft (e.g. 15 or 16) and a cutter (28) having an annular rim (19).

Lill's cutter does not extend below and beyond the shields 1<sup>st</sup> lateral wall, but the cutter is arguable not claimed in these claims. Furthermore, Lill's cutter mount is *capable* of receiving a different cutter that *would* extend beyond and below the 1<sup>st</sup> lateral wall (43).

6. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

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(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

7. Claims 1-5,8 and 9 are rejected under 35 U.S.C. 103(a) as being unpatentable over Lill '165.

Lill, as set forth above, shows most of the recited limitations.

In regards to claim 3, Lill's 1<sup>st</sup> and 2<sup>nd</sup> lateral walls are attached to the same transverse shield wall (39) instead of being attached to two integral transverse shield walls. However, there is no structural difference between single transverse shield walls and two transverse shield walls that are integral with one another. The courts have long ruled that "*the unity or diversity of parts would depend more on the choice of the manufacturer, and the convenience and availability of the machines and tools.....than on any inventive concept*". See In re Lockhart, 90 USPQ 214. Furthermore, Examiner takes Official Notice that it is well known to employ one or two parts in situations such as this. It would have been obvious to one of ordinary skill in the art to have employed two integral transverse shield walls on Lill, instead of just one transverse shield wall, since the courts have ruled this to be obvious and because it is an old equivalent known for the same purpose.

In regards to claims 4 and 9, the bearings 22,22 have a hollow cylindrical portion, a first annular adaptor plate (bottom of 22) and presumably a second annular adaptor plate (top of 22). Since the second annular adaptor plate is not explicitly drawn, Examiner takes Official Notice that it is well known to have such

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annular adaptor plates at the lateral ends of bushing for the purpose of preventing axial sliding. An example of this is the bottom annular adaptor plate on Lill's 22. If it wasn't there already, it would have been obvious to one of ordinary skill in the art to have added a top annular adaptor plate to Lill's adaptor 22 for the purpose of preventing axial sliding.

8. Applicant's arguments have been fully considered but they are not all persuasive.

Applicant's arguments have overcome most of the rejections, and note should be taken that the rejections that remain are employed differently than they were in the previous action.

In regards to claims 12 and 23, Applicant may want to claim that the cutting element extends radially further than any part of the shield.

In regards to claim 1, assuming Applicant still wants protection for the shield alone, Examiner notes that the most difficult devices to claim are those with no moving parts, such as Applicant's shield. The shield alone, without any cutter, could be part of hundreds of different apparatus, most of which the Examiner has not had time to search. Examiner is concerned that even if the Lill rejection is overcome, other references from various arts will come to bear against Applicant's claim 1.

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9. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Ken Peterson whose telephone number is 571-272-4512. The examiner can normally be reached on Mon-Thur, 7:30-5:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Allan Shoap can be reached on 571-272-4514. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

kp  
October 26, 2005



KENNETH E. PETERSON  
PRIMARY EXAMINER